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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,815	04/13/2001	Shinobu Hasegawa	Q64020	5723

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EXAMINER

JIMENEZ, MARC QUEMUEL

ART UNIT

PAPER NUMBER

3726

DATE MAILED: 01/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/833,815

Applicant(s) **MF**

HASEGAWA ET AL.

Examiner

Marc Jimenez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/18/02 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1 and 3** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bresson (5,205,213) in view of van der Velden (4,554,040) and Songer (5,577,443).

Bresson teaches a roller member comprising a core roller 1 (col. 2, lines 15-16) and an unshrinkable sleeve 2 (col. 2, lines 25-46), wherein the core roller 1 is pressed (col. 2, lines 19-21) into the unshrinkable sleeve 2, which sleeve 2 is formed from an elastomer material (col. 2, lines 25-46) and has a thickness of 30-200 micrometers (col. 2, lines 25-46). With respect to the limitations that the roller member is “used in OA apparatuses for imparting a charge, eliminating

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a charge, or removing toner adhered onto the surface of a transfer belt or a transfer-conveyor belt”, note that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). See also the advisory action mailed 11/20/02 which stated that the roller member of the prior art applied in the rejections above have all of the structural features of the claimed roller and are clearly capable of being used in OA apparatuses.

Bresson teaches the invention cited above with the exception of the core being metallic, the sleeve being heat welded onto the surface of the core roller, and the elastomer material having a Young's modulus of 120-200 MPa.

Van der Velden teaches a metallic (col. 1, line 68) core roller 1 and a sleeve 3 being heat welded (col. 2, lines 28-34) onto the surface of the core roller 1.

Songer teaches a printing sleeve that is made with an elastomer material having a Young's modulus of 120-200 MPa (col. 3, line 66).

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Bresson with a metallic core roller and a sleeve that is heat welded onto the surface of the core roller, in light of the teachings of van der Velden in order to provide a rigid and long lasting core roller and in order to securely fasten the sleeve to the core roller. It is noted that in col. 2, lines 19-21 Bresson suggests that “The blanket or sleeve may be fitted by any suitable method onto the cylinder 1...”.

It would have been obvious to one of ordinary skill in the art, at the time of the invention,

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to have provided the invention of Bresson/Van der Valden with a printing sleeve that is made with an elastomer material having a Young's modulus of 120-200 MPa, in light of the teachings of Songer, in order to provide an elastomer material that will permit expansion of the sleeve with relatively low air pressure to facilitate assembly as suggested by Songer at col. 3, lines 52-54.

With respect to Claim 3, note that the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, the limitation that the "welding force between the core roller and the unshrinkable sleeve being 0.1 kg/cm or more" have not been given patentable weight.

4. **Claim 2** is rejected under 35 U.S.C. 103(a) as being unpatentable over Bresson in view of Van der Valden and Songer as applied to **Claim 1** above, and further in view of Clerx et al. (3,937,919).

Bresson/Van der Valden/Songer teach the invention cited above with the exception of the unshrinkable sleeve being selected from a material from the group claimed in claim 2.

Clerx et al. teach a sleeve that is formed from polyamides (col. 2, line 42).

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Bresson/Van der Valden/Songer with a sleeve material made from a polyamide, in light of the teachings of Clerx et al., in order to provide a heat resistant elastically pliable material as suggested by Clerx et al. at col. 3, lines 35-44.

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5. **Claim 4** is rejected under 35 U.S.C. 103(a) as being unpatentable over Bresson in view of Van der Valden and Songer as applied to **Claim 1** above, and further in view of Jinzai et al. (5,717,988).

Bresson/Van der Valden/Songer teach the invention cited above with the exception of having the claimed resistivity of claim 4.

Jinzai et al. teach a sleeve material that has the claimed resistivity (see table 1).

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Bresson/Van der Valden/Songer with the claimed resistivity, in light of the teachings of Jinzai et al., in order to provide a roller having the desired surface resistance.

6. **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over Bresson in view of Van der Valden and Songer as applied to **Claim 1** above, and further in view of Lane et al. (5,983,799).

Bresson/Van der Valden/Songer teach the invention cited above with the exception of having a surface roughness of 5 micrometers or less.

Lane et al. teach a surface roughness that can be 5 micrometers or less (col. 6, lines 13-14).

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Bresson/Van der Valden/Songer with a surface roughness of 5 micrometers or less, in light of the teachings of Lane et al., in order to provide a sleeve that is

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capable of meeting tolerances in the printing industry as suggested by Lane et al. at col. 6, lines 15-16.

7. **Claim 7** is rejected under 35 U.S.C. 103(a) as being unpatentable over Bresson in view of Van der Valden and Songer as applied to **Claim 1** above, and further in view of White et al. (4,089,265).

Bresson/Van der Valden/Songer teach the invention cited above with the exception of the inner diameter of the sleeve being smaller than the outer diameter of the core.

White et al. teach a sleeve with a smaller inner diameter than the outer diameter of the core (see fig. 1).

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Bresson/Van der Valden/Songer with the inner diameter of the sleeve being smaller than the outer diameter of the core, in light of the teachings of White et al., in order to provide a tight fitting sleeve.

Contact Information

8. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information. M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

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If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, or fax (703) 872-9301 or by email to CustomerService3700@uspto.gov.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number is **703-306-5965**. The examiner can normally be reached on **Monday-Thursday and the second Friday of the bi-week, between 9am-6pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 308-6789 or (888) 786-0101
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MJ

January 13, 2003


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TECHNOLOGY CENTER 3700